

REMARKS/ARGUMENTS

Claims 33-34 and 36-37 were pending in this Application. No claims have been added or canceled. Hence, claims 33-34 and 36-37 remain pending in this Application.

Claim Objections

Claims 33 and 36 were objected to by the Examiner because they did not recite the apparatus in a finished condition. Claims 33 and 36 have now been amended to recite the apparatus in a finished condition. Accordingly, withdrawal of the objection against these claims is respectfully requested.

Claim Rejections

Claims 33 and 36 were rejected under 35 U.S.C. §103(a) as being unpatentable over *McCaul* (3,762,115) in view of *Hsu* (5,210,985). The Examiner contends that *McCaul* discloses an apparatus (bathroom module) comprising a seamless housing body unitarily formed as a single piece, having a front wall with a door opening therethrough, a rear wall, two side walls, a roof, a floor, a door frame positioned in the door opening, and a door mounted in the door frame. Although the Examiner concedes that *McCaul* does not disclose the door to be fire resistant and burglary proof, he contends that *Hsu* teaches this aspect of the invention, and it would therefore have been obvious to one skilled in the art to place a fire resistant/burglary proof door on the bathroom module of *McCaul*.

Claims 34 and 37 were also rejected under 35 U.S.C. §103(a) as being unpatentable over *McCaul* in view of *Hsu*, and further in view of *Wokas* (3,162,863). The Examiner contends, as above, that *McCaul* in view of *Hsu* discloses the claimed invention except for the use of a plurality of hooks integrally formed into the housing body for facilitating hoisting the seamless housing body. The Examiner contends, however, that *Wokas* teaches placing lifting means into a housing body of a bathroom module and that it would have been obvious to one skilled in the art to incorporate the teaching of *Wokas* into *McCaul* in view of *Hsu*'s invention.

McCaul and Hsu are not analogous art under 35 U.S.C. §103

In a Final Office Action dated October 9, 2001, the Examiner rejected claims 33-35 as being unpatentable over *Guardini* (4,485,598) in view of the same *Hsu* reference cited above. In a subsequent Appeal Brief dated July 5, 2002, Applicant argued that *Guardini* (directed to prefabricated housing elements) and *Hsu* (directed to a “fire-escaping” room) were not analogous art under 35 U.S.C. §103. The Examiner found Applicant’s arguments at that time to be persuasive and withdrew the finality of the rejection in an Office Action dated September 18, 2002. In the present case, Applicant respectfully submits that *McCaul*, like *Guardini*, is not an analogous prior art reference and that *Hsu* remains a non-analogous reference.

Whether a reference may be treated as analogous art is determined by a two-step process. First, it must be determined whether the reference is “within the field of the inventor’s endeavor.” Second, if the reference is outside that field, it must be determined whether the reference is “reasonably pertinent to the particular problem with which the inventor was involved.” In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986). A reference is reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem. Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve. If a reference has the same purpose as the claimed invention, then the reference relates to the same problem, and that fact would support the use of the reference in an obviousness rejection. In re Clay, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992).

The two-step process was applied in Wang Laboratories, Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993), to find the prior art was non-analogous. In Wang, the patents concerned single in-line memory modules (“SIMMs”) having nine memory chips packaged in plastic leaded chip carriers (“PLCCs”). The prior art disclosed a SIMM with nine memory chips mounted in a single row. The accused infringers argued that the patents were invalid as obvious in view of the prior art. The jury found that the patent was valid.

The Court of Appeals for the Federal Circuit held that substantial evidence supported the jury’s determination that the prior art was neither in the same field of endeavor nor

reasonably pertinent thereto. As to field of endeavor, although both modules were used as computer memories, the court found:

The Allen-Bradley art is not in the same field of endeavor as the claimed subject matter merely because it relates to memories. It involves memory circuits in which modules of varying sizes may be added or replaced; in contrast, the subject patents teach compact modular memories. 993 F.2d at 864, 26 USPQ2d at 1773.

As to reasonable pertinence, the court found that the purpose of the patented invention was to provide a compact module, whereas size was not a consideration in the prior art module.

Applying the two-step process to the present case, neither *McCaul* nor *Hsu* is within the same field of endeavor as the claimed invention. The field of endeavor of the claimed invention is walk-in vaults. See, e.g., page 1, lines 5-8. Note that the term “vault” is recited in the body of Claim 33 as well as in the preamble and throughout the Specification. In contrast, nowhere does the term “vault” appear in either *McCaul* or *Hsu*. Instead, the *McCaul* field of endeavor is prefabricated concrete buildings (see, e.g., col. 1, lines 19-25), and the *Hsu* field of endeavor is fire proof rooms (see, e.g., col. 1, lines 5-11).

The second step in the two-step process outlined by In re Deminski is to determine whether the prior art is reasonably pertinent to the claimed invention. To be reasonably pertinent, the prior art and the claimed invention must share the same purpose. The purpose of the claimed invention is to provide a walk-in vault that can be easily and quickly installed inside a preexisting building. The inventors recognized that, while walk-in vaults were very desirable for their high level of security, existing walk-in vaults had to be built in-place. Being built in-place made walk-in vaults too expensive for the average person and prolonged building construction time. To solve this problem, the inventors created a walk-in vault that is entirely prefabricated. Such a prefabricated walk-in vault could then be quickly and easily installed inside an existing building. See, e.g., page 1, lines 5-22; page 7, lines 11-31; Figures 5-6.

The purpose of *McCaul*, on the other hand, is to be able to construct the building itself (using prefabricated elements), not to add something to an existing building. Indeed, an advantage of *McCaul* is that it allows factory assembly of items that are usually installed after the building has been erected. See, e.g., col. 1, lines 12-16. *Hsu* also has a different purpose

than the claimed invention, namely, to provide a temporary shelter in case of a fire. The aim of *Hsu* is to provide a “fire-escaping” room that can be used as a shelter for waiting out a fire in tall buildings. See, e.g., col. 1, lines 5-52; Abstract.

Accordingly, because *McCaul* and *Hsu* are neither in the same field of endeavor as, nor reasonably pertinent to, the claimed invention, the references cannot be analogous prior art for purposes of 35 U.S.C. §103.

McCaul fails to disclose a seamless housing body

Even if *McCaul* may be used as analogous art, the reference fails to disclose “a seamless housing body unitarily formed as a single piece,” as required by claims 33 and 36. The Examiner relies on col. 3, lines 49-54 and Figures 10 and 11 to show that a seamless housing body has been disclosed. However, nowhere does *McCaul* actually disclose or suggest that the bathroom is **seamless**. The cited text merely discloses a “prefabricated bathroom,” not a **seamless** one, and the cited figures merely show the cross-section of the side walls, roof, and floor. It would be interesting to see the cross-section of the area where the side walls, roof, and floor, meet the end walls, a location that very possibly may have seams. At best, the cited figures are inconclusive. Applicant respectfully reiterates, therefore, that nowhere does *McCaul* actually disclose or suggest that the bathroom is **seamless**.

Hsu fails to disclose a door that is burglary proof

Assuming that the *McCaul* and *Hsu* references are analogous prior art and may be combined in some meaningful manner, *Hsu* fails to disclose a door that is burglary proof, as required by claims 33 and 36. *Hsu* merely discloses a door that is fire resistant. Being fire resistant is an altogether different thing than being burglary proof, which requires an impediment (e.g., a lock) to entry. Indeed, Applicant respectfully submits it would be shortsighted and possibly irresponsible to endow *Hsu* with a burglary proof door. After all, the last thing people should have to do when a fire breaks out is to spend time breaking in to the fireproof room because, for example, they forgot their keys to the burglar proof door during the frantic dash to escape the fire. Therefore, Applicant respectfully submits that the combination of *McCaul* and *Hsu* would fail to produce the claimed invention.

The term “vault” is an affirmative limitation in the claims

The Examiner stated in the current Office Action that the vault limitation should not be given patentable weight because the limitation appears in the preamble of the claim. However, in *Gerber Garment Technology Inc. v. Lectra Systems Inc.*, 916 F.2d 683, 689 (Fed. Cir. 1990), the Federal Circuit held that terms in the preamble that are also referenced in the body of the claim are an integral part of the claim. In the present case, the term “vault” is specifically mentioned in the body of claims 33 and 36 (last element). That term is therefore an integral part of the claim and an affirmative limitation of the claim. Since neither *McCaul* nor *Hsu* is directed to a vault, these references cannot be used to render the claims obvious under 35 U.S.C. §103.

Wokas (3,162,863) is not analogous art under 35 U.S.C. §103

The *Wokas* patent relates to “the prefabrication of rooms, especially restrooms which may or may not contain baths.” It is especially concerned with the “prefabrication of two restrooms that are built together as a single unit package ready for installation in a building.” Therefore, *Wokas* is not analogous prior art for the same reasons that *McCaul* and *Hsu* (and *Guardini*) are not analogous prior art.

Wokas does not disclose a plurality of hooks

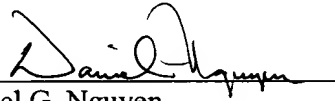
Moreover, assuming that *Wokas* is analogous art, *Wokas* fails to disclose “a plurality of hooks” as required by claims 34 and 37. *Wokas* merely refers to lifting rods, not **hooks**, as urged by the Examiner. This is a significant distinction because the rods can be securely anchored to the floor (see Figure 5) to reduce the strain that is put on the plumbing, fixtures, and walls when the unit is picked up. It would be very difficult to anchor Applicant’s hooks to the floor in the manner taught by *Wokas*.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Respectfully submitted,

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